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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,371	06/22/2001	Brendon Conlan		8049

26453 7590 06/20/2003

BAKER & MCKENZIE
805 THIRD AVENUE
NEW YORK, NY 10022

EXAMINER

PHASGE, ARUN S

ART UNIT	PAPER NUMBER
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1753

DATE MAILED: 06/20/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/887,371	Applicant(s) CONLAN ET AL.	
	Examiner Arun S. Phasge	Art Unit 1753	

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on ____.

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1 and 43-86 is/are pending in the application.

4a) Of the above claim(s) ____ is/are withdrawn from consideration.

5) ☐ Claim(s) ____ is/are allowed.

6) ☒ Claim(s) 1 and 43-86 is/are rejected.

7) ☐ Claim(s) ____ is/are objected to.

8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

 a) ☒ All b) ☐ Some * c) ☐ None of:

 1. ☐ Certified copies of the priority documents have been received.

 2. ☒ Certified copies of the priority documents have been received in Application No. 09/470,823.

 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

 * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

 a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u>	6) <input type="checkbox"/> Other:

DETAILED ACTION

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 1 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6464851. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See

In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 43-86 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 6,464,851 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims when read in light of the specification clearly encompass and render obvious the claimed method.

The method of the prior patent disclose the separation of blood protein from a pathogen, including the group presently claimed, comprising the steps of providing a biological liquid with potential pathogens present in an apparatus comprising an anode and a cathode and a separation means, such as the membranes claimed, positioned between said anode and said cathode, applying current between said anode and cathode causing one of said pathogens or said protein to pass said separation means and recovering the protein essentially free of pathogens (see

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claims 1-36). The reference further discloses the size of the pores (see claim 30).

The patent further claims the use of multiple membranes (see claims 10-18).

The reference does not disclose that the separation means is a filtration means, such as ultrafiltration or nanofiltration membrane. The membranes claimed in the prior patent would encompass the presently claimed range. Accordingly, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made that the present claims are obvious embodiments of the prior patent, because the prior patent discloses the broad range of materials being treated and membranes.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 43-86 are rejected under 35 U.S.C. 102(b) as being anticipated by Mullon et al. (Mullon), article entitled, "Forced-Flow Electrophoresis of Proteins and Viruses.

Mullon discloses the claimed method and apparatus for the removal of either a pharmaceutically active molecule from a pathogen or a pathogen from a pharmaceutically active molecule in a biological liquids comprising the steps of providing a biological liquid, where pathogens are potentially present in an apparatus comprising an anode and a cathode and a separation means, such as the semi-permeable membrane, applying current between the anode and cathode to cause one of said pathogens or pharmaceutically active molecules to pass said separation means and recovering the molecule essentially free of pathogens (see pages 124-126). The reference discloses the selection of different cut-off values for the membranes, which would read upon the claimed membranes and different filtration characteristics (see pages 123-126). The reference further shows the use of at least four different chambers (see figures 1 and 2). The reference further discloses the separation of viruses from protein (see page 134).

Therefore, the claims are anticipated.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun S. Phasge whose telephone number is

(703) 308-2528. The examiner can normally be reached on MONDAY-THURSDAY,
7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the
examiner's supervisor, Nam X Nguyen can be reached on (703) 308-3322. The fax
phone numbers for the organization where this application or proceeding is
assigned are (703) 872-9310 for regular communications and (703) 872-9311 for
After Final communications.

Any inquiry of a general nature or relating to the status of this application
or proceeding should be directed to the receptionist whose telephone number is
(703) 308-0661.

A handwritten signature in black ink, appearing to read 'Arun Phasge', with a large, stylized initial 'A'.

Arun S. Phasge
Primary Examiner
Art Unit 1753

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June 16, 2003